

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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CHRISTOPHER BROOKS, :

Opposer, :

v. : Opposition No. 91160266

CREATIVE ARTS BY CALLOWAY, LLC, :

Applicant. :

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APPLICANT'S MEMORANDUM IN OPPOSITION
TO OPPOSER'S MOTION FOR RECONSIDERATION OF
OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Introduction

Opposer Christopher Brooks ("Opposer") moved for summary judgment claiming prior rights in the service mark THE CAB CALLOWAY ORCHESTRA and likelihood of confusion. In response to Opposer's motion for summary judgment, Applicant Creative Arts By Calloway, LLC ("Applicant") disputed Opposer's claim of priority, raised serious questions about the probative value of the untested evidence Opposer submitted in support of his priority claim, and proffered evidence demonstrating that Applicant in fact is the party with priority.

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I hereby certify under 37 CFR §2.197 that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

January 11, 2006

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The Trademark Trial and Appeal Board (the “Board”) denied Opposer’s motion for summary judgment, holding, among other things, “that opposer has not met his burden of establishing that there are no genuine issues of material fact and that he is entitled to summary judgment as a matter of law.”

In denying summary judgment, the Board also advised the parties that it did not consider Opposer’s reply brief in support of his motion for summary judgment because that brief failed to comply with the Board’s page limit requirements (although the Board did note that it did consider the rebuttal evidence submitted with Opposer’s reply brief).

The Board’s holdings are correct and should not be reconsidered or changed.

I. Standard of Review

A motion for reconsideration should only be granted if, “based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued.” TBMP § 518. The facts before the Board, and the prevailing authority, plainly establish that, at a minimum, serious factual issues exist relating to Opposer’s claim of priority.¹ As such, the Board did not err in recognizing the complexity of this case and refusing to dispose of the highly fact-laden issue of priority on summary judgment.

II. Argument

A. The Board Rightly Recognized that the Record on Summary Judgment Did Not Establish that Opposer is Entitled To Judgment as a Matter of Law

1. Priority Must Be Determined at Trial

Opposer’s claim of priority is based on self-serving statements, documents that do not even remotely establish what they purport to establish, and a prior civil action that has no bearing

¹ A concise overview of the material facts in dispute in this proceeding is set forth in Applicant’s Response to Opposer’s Statement of Undisputed Facts, filed as Exhibit A to Applicant’s Memorandum in Opposition to Opposer’s Motion for Summary Judgment.

on the issues presently before the Board. Opposer's evidence is untested by cross examination, is seriously lacking in both quantum and probative value, and has been significantly rebutted by Applicant.

For instance, in an attempt to establish rights in the mark THE CAB CALLOWAY ORCHESTRA, Opposer submitted a declaration in which he states that he has been using the service mark THE CAB CALLOWAY ORCHESTRA in connection with entertainment services since December 1998. *See* Declaration of Christopher Brooks in Support of Opposer's Motion for Summary Judgment ("Brooks' Decl."), ¶ 7. In support of this self-serving assertion, Opposer cites three agreements alleged to be between Opposer and a "sponsor." Brooks Decl., ¶ 7, Ex. 3.

As pointed out by Applicant in its Response to Opposer's Statement of Undisputed Facts, the agreements on which Opposer relies do not evidence service mark use of the designation THE CAB CALLOWAY ORCHESTRA. *See* Applicant's Response to Opposer's Statement of Undisputed Material Facts, ¶ 5. The agreements are not proof that Opposer actually rendered any services on a specific date. In fact, the agreements themselves state that "[a]rtist is not liable for failure to appear or perform on the schedules [sic] date in the event of illness, severe weather, or other extreme or unusual conditions beyond artist control....The program is subject to change." *Id.* Moreover, the agreements do not evidence that Opposer used the service mark THE CAB CALLOWAY ORCHESTRA in connection with any performance on a specific date. The three documents, which serve as Opposer's sole documentary evidence of his claimed priority with respect to entertainment services, do not prove – as a matter of law – that Opposer has priority.

In an attempt to bolster his claim of rights, which Opposer may only establish by proving secondary meaning (*see* Applicant's Memorandum in Opposition to Opposer's Motion for

Summary Judgment, pp. 3-9), Opposer alleges that THE CAB CALLOWAY ORCHESTRA mark has become “well-known, recognized and famous over the last six years” and that his orchestra “has received a great deal of media coverage over the last six years.” Brooks Decl., ¶ 10. The documents Opposer cites in support of this claim are six news articles, which are plainly insufficient to establish secondary meaning. Even if Opposer were not required to demonstrate secondary meaning, not a single news article submitted by Opposer bears a date before Applicant’s July 23, 1999 statutory priority date. Brooks Decl., Ex. 6. Indeed, the most historic article Opposer proffered is from October 7, 2000 – well over a year after Applicant’s statutory priority date.² *Id.* Moreover, four of the six articles Opposer submitted were retrieved from Westlaw, indicating that Opposer, or his counsel, conducted a broad search on a Westlaw news database and only unearthed four articles written about Opposer’s musical performances.

The documents submitted by Opposer to support his priority claim are woefully short of establishing priority as a matter of law. The conclusions Opposer draws from those documents are plainly in dispute, and have not been tested by cross examination. The Board properly recognized that the record on summary judgment does not entitle Opposer to judgment as a matter of law.

2. The Board Recognized that Applicant Is Entitled To Prove Prior Rights In the CAB CALLOWAY Mark

Opposer alleges that he has priority based on a purported use of the service mark THE CAB CALLOWAY ORCHESTRA in December 1998. Brooks Decl., ¶ 7. Applicant proffered evidence refuting Opposer’s allegation and demonstrating that Applicant in fact has prior trademark and service mark rights in the CAB CALLOWAY designation. In particular,

² Similarly, the advertisements and other materials submitted by Opposer in an attempt to demonstrate service mark rights do not relate to performances rendered before Applicant’s statutory priority date. Brooks Decl., Exs. 4, 5.

Applicant's evidence establishes that Applicant has used, through licensees or predecessors in interest, the CAB CALLOWAY mark in connection with goods and services identified in and/or closely related to those services identified in the Application well before Opposer's claimed first use date.³ See Declaration of Cabella Calloway Langsam In Support of Applicant's Opposition to Opposer's Motion for Summary Judgment, ¶¶ 9-19.

In denying Opposer's motion for summary judgment, the Board held that "Applicant is entitled to prove earlier use of the CAB CALLOWAY mark in connection with the recited services in International Classes 35 and 41 than its intent-to-use application filing date." Board's Decision, 2, n.2. By specifically mentioning Applicant's right to prove a priority date that precedes its statutory priority date, the Board recognized that a material issue of fact exists as to which party has priority. This factual disputes must be sorted out at trial, not on summary judgment.

3. The Board's Statement About an Issue of Fact as to the Relatedness of the Goods and Services Must Be Read In Conjunction with the Accompanying Footnote Addressing the Prior Litigation

In holding that Opposer is not entitled to judgment as a matter of law, the Board stated that, "[a]t a minimum, there is a genuine issue of material fact as to the relatedness of opposer's goods and services and those of the applicant." Board's Decision, 2. Opposer, in his Motion for Reconsideration, misinterprets that statement as referring to the issue of likelihood of confusion raised by Opposer in this proceeding, and overlooks the fact that the Board's statement is followed by, and therefore explained by, a footnote addressing the prior civil litigation between the parties. Board's Decision, 2 n.1

³ See Applicant's Memorandum in Opposition to Opposer's Motion for Summary Judgment, pp. 13-18, explaining that Applicant may tack earlier use of the mark to its statutory priority date since the mark was previously used in connection with goods or services substantially identical to those recited in the application. See also *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991); *Big Blue Prods. Inc. v. Int'l Business Machines Corp.*, 19 USPQ2d 1072, 1075 (TTAB 1991).

In that footnote, the Board states that “it is not clear that applicant’s services that are the subject of the application in this case were addressed by the courts in the prior proceedings. Therefore, we cannot give the decision preclusive effect in this motion for summary judgment.” *Id.* Because the Board expanded on its statement regarding the relatedness of the goods and services with a footnote addressing the services at issue in the prior litigation, the Board held a genuine issue of material of fact exists as to whether Opposer’s and Applicant’s goods and services at issue in the prior litigation are the same as the goods and services at issue in the present proceeding. If the goods and services at issue in the prior litigation are different from the goods and services at issue in the present proceeding, then the prior litigation cannot have a preclusive effect. Recognizing this, the Board held that summary judgment for Opposer is not appropriate because the prior litigation did not determine the issue of priority.

In addition, the Board noted that its citation of one genuine issue of material fact should not be construed as a finding that other material fact issues do not exist. Board’s Decision, 2 n.2. As Applicant has demonstrated, significant issues of fact continue to exist rendering this proceeding unsuitable for resolution on summary judgment.

B. The Board’s Refusal to Consider Opposer’s Reply Brief was Proper

Categorizing the Board’s refusal to consider its overlong reply brief as “an error of law” (Motion for Reconsideration p. 7), Opposer rails against the Board’s decision on several grounds, all but ignoring the most important consideration. In *Saint-Gobain Corp. v. Minnesota Mining and Mfg. Co.*, 66 USPQ2d 1220 (TTAB 2003), the Board announced – in a precedential opinion that dealt with no other subject – the interpretation of its rules that it applied here. Like this case, *Saint-Gobain* was a determination of a summary judgment motion. As it did here, the Board imposed the sanction of refusal to consider overlong briefs. The Board’s interpretation of

its own rules is certainly a permissible, if not the only permissible, reading of its rules. Whatever excuse there may have been before *Saint-Gobain* (and even then, caution dictated that one assume the worst in counting pages), there can hardly be an excuse now. The Board makes its own rules, and when it does so in a precedential decision, it has a right to expect that the bar will take notice and comply.

The proposed spelling out the Board's practice in its rules will make the interpretation somewhat less of a trap for the unwary (hardly an apt characterization of the firm that represents Opposer – see www.frosszelnick.com), but it certainly doesn't "attest[] to the absence of any such established rule at the present time." Motion for Reconsideration, p. 8. The ten page limit rule was and is in place, as was and is its interpretation in *Saint-Gobain*.

Conclusion

For the foregoing reasons, Applicant respectfully requests that the Board deny Opposer's motion for reconsideration and allow this proceeding to promptly move to the testimony period.

Respectfully submitted,

FISH & RICHARDSON P.C.

Dated: January 11, 2006

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing APPLICANT'S
MEMORANDUM IN OPPOSITION TO OPPOSER'S MOTION FOR RECONSIDERATION
OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT has this 11th day of January 2006
been mailed by prepaid first class mail to the below-identified Attorney at his/her place of
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